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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,594	05/03/2001	Sujal Bhalakia	589.063US2	8703

7590 06/02/2003  
OPPENHEIMER WOLFF & DONNELLY LLP  
840 NEWPORT CENTER DRIVE  
SUITE 700  
NEWPORT BEACH, CA 92660

EXAMINER

ZACHARIA, RAMSEY E

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 06/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

A-8-13

**Office Action Summary**

Applicati n N .

09/848,594

Applicant(s)

BHALAKIA ET AL.

Examiner

Ramsey Zacharia

Art Unit

1773

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 50-79 is/are pending in the application.
- 4a) Of the above claim(s) 59-79 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 50-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,9,10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 59-79 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper No. 12.

### *Information Disclosure Statement*

2. References A4 and A6-A26 in the Information Disclosure Statement filed 08 July 2002 have been lined through because these references were presented and considered in the Information Disclosure Statement filed 13 August 2001. References A1-A26 in the Information Disclosure Statement filed 05 July 2002 have been lined through because these references were presented and considered in the Information Disclosure Statements filed on 13 August 2001 and 08 July 2002.

3. References C6 and C7 in the information disclosure statement filed 03 September 2002 have been lined through because they fail to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because they have no date of publication. Moreover, reference C7 is in Japanese and there is no concise explanation of its relevance in English. They have been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements

Art Unit: 1773

based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

### ***Specification***

4. The specification is objected to because of informalities such as: graphic formula I on page 14 is blank, etc.

The applicant is requested to review the application thoroughly and make all appropriate corrections.

### ***Claim Objections***

5. Claim 53 is objected to because of the following informalities: "expoxy-type" appears to be a typographical error that should read -- epoxy-type --. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 50-57 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawaki et al. (U.S. Patent 5,051,309).

Kawaki et al. teach a polarizing plate comprising a polarizing polymeric film (i.e. a functional layer) and polycarbonate plates (i.e. first and second resinous layers) bonded to both

Art Unit: 1773

surfaces of the polymeric film (column 2, lines 22-29). The plates are bonded to the film using acrylic-type, epoxy-type, or urethane-type adhesives (column 3, lines 51-59).

The adhesives used by Kawaki et al. are taken to inherently have sufficient flexibility so as to substantially prevent crazing during molding, substantially prevent yellowing, and minimize shrinkage during cure since they appear to be the same adhesives used in the instant application (i.e. acrylic-type, epoxy-type, or urethane-type adhesives).

Regarding claims 55 and 56, the limitations of these claims are directed to the molded lens that the laminate is to be used to make. As such, they are limitations directed to the intended use of the laminate and not structural limitations of the laminate itself. Since it has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations (see *Ex parte Masham*, 2 USPQ2d 1647 (1987)), the laminate of Kawaki et al. is taken to meet the limitations of claims 55 and 56.

8. Claims 50-56 and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by Gulati et al. (U.S. Patent 4,268,134).

Gulati et al. teach a laminate comprising plastic layers bonded on either side of a glass layer by means of bonding layers (Figure 3 and column 1, line 64-column 2, line 2). The bonding layers comprise a material that possesses a relatively low modulus of elasticity (column 2, lines 13-19). The adhesive has good optical clarity and minimum light absorption throughout the visible light range, including the yellow wavelengths (column 5, lines 15-24). The adhesive

Art Unit: 1773

is preferably a polyurethane adhesive (column 5, lines 46-52). The glass layer is a photochromatic layer (column 5, lines 58-61).

The adhesive used by Gulati et al. is taken to inherently have sufficient flexibility so as to substantially prevent crazing during molding, substantially prevent yellowing, and minimize shrinkage during cure since it appear to be the same as an adhesive used in the instant application (i.e. a urethane adhesive). Moreover, Gulati et al. explicitly teach minimizing the absorption of visible light by the adhesive.

Regarding claims 55 and 56, the limitations of these claims are directed to the molded lens that the laminate is to be used to make. As such, they are limitations directed to the intended use of the laminate and not structural limitations of the laminate itself. Since it has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations (see *Ex parte Masham*, 2 USPQ2d 1647 (1987)), the laminate of Gulati et al. is taken to meet the limitations of claims 55 and 56.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Zacharia whose telephone number is (703) 305-0503. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the

Art Unit: 1773

organization where this application or proceeding is assigned is (703) 872-9310 for non after-final correspondences and (703) 872-9311 for after-final correspondences.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'MZC' with a stylized flourish at the end.

Ramsey Zacharia

Primary Examiner

Technology Center 1700

5/30/03